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| 09/678,570      | 10/03/2000  | Thomas J. Reid       | 55409USA3A.002      | 5623             |

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EXAMINER

YAO, SAMCHUAN CUA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/678,570

Applicant(s)

REID ET AL.

Examiner

Sam Chuan C. Yao

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 17-31 and 34-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Election/Restrictions*

1. In light of Counsel's amendment, a new restriction requirement was made.

**Rejoinder of all non-elected groups will be considered upon indication of patentable subject matter, depending on the basis thereof.**

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-16 and 32-33, drawn to a method of finishing brightwork on a boat. The independent claim in this group requires (for example) applying a finishing film onto a "*wood substrate ..., the wood substrate comprises the brightwork*" on a boat (**A**).
  - II. Claims 17-31 and 36-37, drawn to a finishing a wood surface. The independent claims in this group requires (for example) applying a liquid vanish on a wood substrate (**B**).
  - III. Claims 34-35, drawn to a method of finishing a wood surface. The independent claim in this group requires (for example) applying an oil or sealer on a wood substrate which leaves the natural grain of the wood exposed (**C**).

The inventions are distinct, each from the other because of the following reasons:

Groups I-III are directed to distinct methods. The patentability in the independent claims of each group is based on divergent combination of method steps. For instance, independent claim 1 requires patentable subject matter **A**, but does not require **B** or **C**. Similarly, each independent claim in groups II or III requires a particular patentable

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subject matter, but does not require certain patentable subject matter recited in the other groups. The differences between these groups are critical and significant to the extent that the inventions constitute prima facie patentably distinct combinations, absent evidence to the contrary. This can readily and clearly be demonstrated by a side-by-side comparison of the independent claims noted earlier. Similarities of the independent claims are merely superficial, since certain significant limitations in one of the groups find no counterpart in the other group(s) and vice versa. In fact, in Counsel's response to the last office action, Counsel repeatedly argued on pages 11-12 that, the references applied do not teach "*applying a finishing film material to brightwork on a boat (independent claim 1), vanish on a wood substrate (independent claims 17 and 36), and oil or sealer on a wood substrate (independent claim 34).*".

3. During a telephone conversation with Mr. Dennis Daley on 02-26-04 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-16 and 32-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-31 and 34-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-16 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogstoel (US 3,607,540) in view of the Admitted Prior Art (APA).

The discussion of the Hoogstoel patent is set forth in a prior office action dated 3-26-02. Hoogstoel differs from claims 1, 8, 13-14 and 32, in that, Hoogstoel does not teach applying a decorative sheeting onto a wood substrate of a boat, the wood substrate comprises a brightwork. However, it would have been obvious in the art to apply a decorative sheet taught by Hoogstoel onto a wood substrate of a boat, the wood substrate comprises an already dried brightwork, because: a) *"Many boats are appointed with brightwork, that is interior or exterior wood that has been finished with a non-opaque varnish, oil or sealer that leaves the natural grain of the wood exposed"* as disclosed by the APA (specification; page 1 lines 10-12); and, it is a notoriously common practice in the art to apply a decorative covering onto at least a portion of a wood wall surface of a boat in order to enhance the aesthetic appearance of the boat. A preference on whether or not to apply a decorative covering on a wooden wall surface of a boat is taken to be well within the purview of choice in the art.

With respect to claim 2, see Applicant's specification on page 1 lines 12-13.

With respect to claims 3-7 and 9-10, since it is conventional in the art to form a backing film from a flexible aliphatic polyurethane having the recited elongation; since a decorative covering with an adhesive having the recited thickness is notoriously well known in the art; since it is a common practice in the art to form a

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polymeric film where a UV absorber, the limitations in these claims would have been obvious in the art making decorative coverings taught by Hoogstoel.

Hoogstoel teaches using a glycerin or ethylene glycol a barrier layer to a PSA and applying a wetting agent onto the barrier layer. However, Hoogstoel does not teach applying such a barrier layer onto a wood substrate and then applying a wetting agent onto the barrier layer. However, it would have been obvious in the art to apply a glycerin or ethylene glycol barrier layer onto a wood substrate instead of applying it on a surface a PSA and then apply a wetting agent onto the barrier layer, as such is taken to be well within the purview of choice in the art.

One in the art would have readily understood that, whether a barrier layer is applied onto a PSA or a wood substrate, the barrier layer would effectively perform the same function of allowing a PSA coated backing film to shift without tearing or wrinkling the backing film.

With respect to claims 11-12, see Applicant's specification on page 1 lines 21-24.

It is old in the art to use an aliphatic polyurethane polymer disperse in a solvent in forming a brightwork surface of a wood substrate.

With respect to claims 15-16, see the rejection set forth in a prior office action dated 03-26-02 numbered paragraph 8.

With respect to claim 33, it would have been an obvious expediency in the art to apply pressure onto a decorative covering as the covering is being adhesive bonded onto a wooden substrate of a boat using a pressure sensitive adhesive in order to effectively bond the covering onto the wooden substrate.

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6. Claims 1-2, 5-12, 15-16, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriya et al (US 5,256,472) in view of Admitted Prior Art (APA).

Moriya et al, drawn to a weather-resistant film coated with a PSA, substantially discloses the process recited in claim 1. Moriya et al differs from claim 1 in that, Moriya et al does not teach applying a weather-resistant film onto a wood substrate of a boat, the wood substrate comprises a brightwork. However, it would have been obvious in the art to apply a weather-resistant film taught by Moriya et al onto a wood substrate of a boat, the wood substrate comprises an already dried brightwork, because: a) *"Many boats are appointed with brightwork, that is interior or exterior wood that has been finished with a non-opaque varnish, oil or sealer that leaves the natural grain of the wood exposed. ... Although beautiful when first finished, the appearance of exterior brightwork often deteriorates rapidly due to the harsh combination of sunlight and moisture."* as disclosed by the APA (specification; page 1 lines 10-18); b) Moriya et al teaches applying a fluorine resin type protective film onto a wood substrate to provide an excellent *"weather resistance, stain resistance, toughness such as chemical resistance, ..."* (col. 1 lines 11-20; col. 2 lines 21-27); and, c) a transparent fluoropolymer is notoriously well known in the art.

With respect to claims 2, 5-12, and 31-32, these claims would have been obvious in the art for essentially the same reasons set forth above.

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7. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references set forth in numbered paragraph 3 as applied to claim 1 above, and further in view of Hoogstoel (US 3,607,540).

Since Hoogstoel teaches applying a wetting agent onto a surface of PSA so that a wall covering can readily be repositioned without being wrinkled, these claims would have been obvious in the art applying a protective film taught by Moriya et al on a wood substrate of a boat.

### ***Response to Arguments***


8. Applicant's arguments with respect to claim 1 has been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sam Chuan C. Yao  
Primary Examiner  
Art Unit 1733

Scy  
02-27-04